

Priority

Applicants respectfully submit that the "Priority" portion of the Office Action has not made a rejection with respect to the claims. Particularly, the claims, e.g. claim 1, defines a colorless glass. The action has failed to raise a rejection to claims including this terminology. As such, the action fails to provide an avenue for an appeal to the Board of Patent Appeals and Interferences on this issue.

The Office Action is in error in stating that the current specification and parent specification are not identical. They are identical. Thus, the current application is properly indicated as a continuation and it would be improper to indicate it as a continuation-in-part. The fact that new claims are provided in this application does not change the proper "continuation" status of this application.

Furthermore, the standard for determining compliance of a claim with 35 U.S.C §120 to obtain the filing date of an earlier filed U.S. application is not whether the specifications are identical. Rather, there are six conditions for receiving the benefit of an earlier filing date (see, e.g., M.P.E.P. §201.11), with the condition relevant to the current discussion being that the claim is entitled to an earlier filing date if the subject matter of the claim is disclosed in the manner provided in 35 U.S.C§ 112, first paragraph, in the earlier filed application. See, e.g., *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 47 U.S.P.Q.2d 1829 (Fed. Cir. 1998); and M.P.E.P. §201.11. With respect to whether the subject matter of the pending claims is disclosed in the manner provided by 35 U.S.C §112, first paragraph in the parent Application No. 09/532,966, Applicants respectfully submit that the pending claims are supported, as further discussed below.

As discussed in Applicants' last reply, the Board noted that the Appellants had not provided evidence that the specification provided written support for the term "colorless," and asserted that mere attorney argument is insufficient to overcome the Examiner's *prima facie* showing that the claims are unpatentable under 35 U.S.C §112, first paragraph. However, *res judicata* is not applicable when the same issue and same fact setting is not involved. See M.P.E.P. §706.03(w). The Office Action here improperly relies on the Board's decision in supporting the objection to priority.

First, the issue of whether Applicants complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C §120 was not before the Board in the prior decision. The issue before the Board was a rejection under 35 U.S.C §112 of whether the specification supported the term "colorless" in a claim. Consequently, whether the claims of the present application have a priority claim is not subject to *res judicata*.

Therefore, it is improper for the Action to deny Applicants' priority claim until the issue of the term "colorless" in view of the new evidence is examined with respect to the requirements of 35 U.S.C §112.

Also, in the instant application, a declaration and exhibit were provided with Applicants' last reply providing evidence that the present specification, which is identical to the parent specification as discussed above, inherently provides support for the term "colorless". Consequently, a decision based on *res judicata* is improper because different facts are present before the Examiner than were before the Board, with respect to 35 U.S.C §112, first paragraph. Specifically Applicants have now included evidence in the record that the parent specification provides inherent support for the claimed "colorless" glass. This evidence was not before the Board. Thus, the Board's Decision is no longer applicable.

Although the action fails to provide a ground of rejection, it substantively addresses the declaration under the priority objection. Particularly, the action alleges that the terminology "decolorant" in the disclosure encompasses compounds that counteract the effect of iron even if the effect is the addition of a color. Both decolorants listed in the instant disclosure are allegedly known to have a coloring effect. Thus, the action asserts that the Applicants have not shown by way of tangible evidence that the additional listed decolorants still result in a colorless glass.

Applicants respectfully submit that these assertions are erroneous. Particularly, the action ignores the specification and prosecution history of the Parent Application No. 09/532,966 filed 22 March 2000, as well as the recently submitted declaration. As discussed in the Reply Brief 5 August 2002, the specification at page 3 provides:

It is also possible for decolorants, such as, for example Er_2O_3 or CoO , to be included, which counteract or hide the coloring effect of iron which is usually present in the raw materials.

Emphasis added.

As discussed in the specification, the decolorant counteracts or hides the coloring effect of iron. The rationale by the Board for sustaining the rejections was that Appellants failed to establish that a glass as disclosed at, e.g., page 2 of the specification, was in fact colorless. The declaration submitted with Applicants' last reply provides more than sufficient evidence that such a glass is colorless. The optional decolorant is only added if such a glass contains impurities, such as iron. Thus, as discussed in the prosecution of the parent application, if such a glass as disclosed at page 2 has an impurity which would render it not colorless, an optional decolorant can be added to counteract or hide such a color to render the glass colorless. See, e.g., Appellants' Appeal Brief filed 25 April 2002, Reply Brief filed 5

August 2002, and Reply Brief filed 5 November 2002, along with accompanying attachments, in Application No. 09/532,966. Additionally, the declaration at page 4 provides evidence that the decolorant is optional to offset impurities and result in a colorless glass. Consequently, Applicants respectfully submit that there is sufficient evidence so that one of ordinary skill the art would readily recognize that the term "colorless" is inherently supported by the specification.

Specification Objections

Applicants note that the specification is objected as not providing antecedent basis for the term "colorless". Applicants respectfully submit that once the issues pertaining to the term "colorless" are resolved in the claims, Applicants will consider amending the specification to include the term "colorless". It is noted, however, that the specification need not provide literal support; inherent or implicit support is sufficient. See, e.g., *In re Wertheim et al.*, 541 F2d. 257, 191 U.S.P.Q. 90 (CCPA 1976). In this case, as shown by the declaration the "colorless" feature of the glass is inherently disclosed. Thus, it should not be necessary to amend the specification to add the "colorless" term. At this time, it appears premature to amend the specification until these other issues are resolved.

Claim Rejections Under 35 U.S.C §102

Claims 5, 8 and 9 stand rejected as allegedly being anticipated by U.S. Patent No. 5,288,668 (Netter). With respect to claim 5, Applicants respectfully submit that the declaration submitted with the last reply establishes that the manganese oxide of Netter is a colorant, not a decolorant. As discussed above, this evidence was not before the Board in deciding the appeal in the parent application, thus *res judicata* does not apply. Thus, applicants respectfully submit that Netter does not anticipate the invention as defined by claim 5. The allegation in the Office Action that the showing in the declaration is not commensurate in scope with claim 5 is not relevant to the issue here. The declaration establishes that the manganese oxide in Netter is not a decolorant. The declaration is not a showing unexpected properties of the claimed invention but a showing that the prior art does not meet an element of the claim. The scope of the showing with regard to Applicants' claim is not relevant to this issue.

With respect to the terminology "consisting essentially of" in claim 8, Applicants respectfully submit that this terminology excludes materials that would materially affect the basic and novel characteristics of the claimed glass. With respect to Netter, Netter exemplifies using some amounts of MnO₂. The declaration provides evidence that MnO₂ in

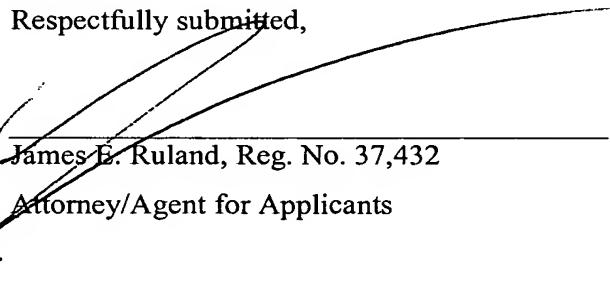
such amounts used in Netter acts as a colorant, and as such, would affect the basic and novel characteristics of the glass as defined by claim 8. Consequently, Applicants respectfully submit that claim 8 defines over Netter in view of this newly submitted evidence.

Claims 1-21 stand rejected as allegedly being anticipated by GB 2348197 (GB) and Japanese document 2000-290037 (JP). Applicants respectfully submit that the present application has an effective filing date of the parent application No. 09/532,966, filed March 22, 2000, as discussed above. Consequently, Applicants respectfully submit that these rejections should be withdrawn.

In view of the above, favorable reconsideration is courteously requested. If there are any remaining issues which can be expedited by a telephone conference, the Examiner is courteously invited to telephone counsel at the number indicated below.

The Commissioner is hereby authorized to charge any additional fees associated with this response, and not included herewith, or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,


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Attorney Docket No.: SGW-0097-C02

Date: 24 January 2005

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